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REMARKS**CLAIM REJECTIONS – 35 U.S.C. § 102 OVER LAPIDOUS**

Claims 1, 3, 5-8, 9, and 14-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lapidous (U.S. Patent No. 6,874,126). To anticipate claims 1, 3, 5-8, 9, and 14-16 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Lapidous must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Lapidous must enable Applicants' claims. Lapidous does not meet either requirement and therefore does not anticipate Applicants' claims.

Lapidous Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Lapidous does not disclose each and every element of claim 1, and Lapidous therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Independent claim 1 of the present application claims:

1. A computer program product embodied in a machine readable media and executable by a processor, said computer program product for use with a computer system having a display screen, a switch, and a pointing device for moving a cursor image on the display screen, said computer program product comprising program instructions for performing the steps of:

displaying an object on the display screen;

displaying a tooltip on the display screen in response to the positioning of the cursor image over the object,

continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.

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Lapidous Does Not Disclose Continuing To Display
The Tooltip In Response To The Movement Of The
Cursor From The Object To The Tooltip

The third element of claim 1 claims "continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip." Regarding the third element of claim 1, the Office Action at page 3 states that Lapidous at Figure 2, reference numeral 230, discloses:

continuing to display the tool tip in response to the movement of the cursor from the object to the tool tip (figure 2, cursor 230 is still placed over the tool tip).

That is, the Office Action takes the position that Lapidous at Figure 2, reference numeral 230, discloses the third element of claim 1 because the cursor 230 of Figure 2 in Lapidous is placed over the tool tip. Applicants respectfully note in response, however, that the cursor 230 of Figure 2 in Lapidous is placed over a floating control region 220 of Lapidous -- not over a tool tip in Figure 2 of Lapidous. In fact, the element depicted in Figure 2 of Lapidous as tool tip is pop-up window 205 of Figure 2 in Lapidous. Lapidous at column 12, lines 7-17, describes pop-up window 205 of Figure 2 stating:

In the embodiment shown in FIG. 2, link 225 related to the supplemental content is rendered as an indicator that the main content can be replaced by clicking inside control region 220. In this way, the user is provided with a familiar metaphor of a tool tip, where pop-up window 205 starts behaving as a tool tip in relation to link 225 located inside the control region 220. That is, a control region surrounds a link while the associated content is displayed, and a cursor motion outside of the control region causes removal of the associated content.

That is, Lapidous at column 12, lines 7-17, describes pop-up window 205 of Figure 2 as a tool tip in relation to link 225 inside the control region 220. Because the cursor is not even close to the pop-up window 205 of Figure 2 in Lapidous, Lapidous's cursor 230 of Figure 2 cannot disclose continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application.

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Even if the control region 220 were a tool tip, which it is not, Lapidous at Figure 2 does not disclose continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application because the control region 220 is not continuously displayed in response to the movement of the cursor from the object to the control region 220. The Office Action at page 2 asserts that the element of Figure 2 in Lapidous corresponding to the 'object' of claim 1 of the present application is the 'More information' region of Figure 2 in Lapidous stating:

displaying an object on the display screen (figure 2, "More information" region, column 6, lines 3-5)....

The control region 220 of Figure 2, however, is not displayed when the cursor 230 of Lapidous is over the 'More information' region of Figure 2 in Lapidous— rather, the floating control region 220 of Figure 2 in Lapidous is rendered beneath the cursor 230 of Figure 2 in Lapidous after the cursor 230 reaches the location of the cursor 230 depicted in Figure 2 of Lapidous. Lapidous at column 6, lines 23-36, states:

In this embodiment, once it is detected that the supplemental content is visible on the screen, the cursor motion is monitored for identifying a particular predefined event related to the cursor motion. This event may be a reduction in the cursor motion, an absence of the cursor motion for a predefined time interval, a particular movement of the cursor (e.g., a gesture to reproduce a circle), or any other similar event.

Once this event is identified, the cursor position at the time of this event is determined, and a floating control region is defined covering the cursor position. This control region is referred to as "floating" because its location on the screen is not fixed and depends on the cursor position at the time of the event.

That is, Lapidous at column 6, lines 23-36, states that the floating control region 220 is defined to cover the position of cursor 230 of Figure 2 in Lapidous. Once the cursor leaves the floating control region 220, the floating control region 220 of Figure 2 in Lapidous becomes invisible as described in Lapidous at column 6, lines 48-51, stating:

Once it is detected that the cursor is positioned outside of the control region, the supplemental content is removed from the screen. At this time, the control region also becomes invisible.

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Because the floating control region 220 of Figure 2 in Lapidous is rendered at the location of the cursor 230 of Figure 2 in Lapidous and becomes invisible when the cursor 230 leaves the location depicted in Figure 2 of Lapidous, the control region 220 of Figure 2 in Lapidous is not continuously displayed in response to the movement of the cursor from the 'More information' region to the control region 220. Lapidous at Figure 2, therefore, does not disclose continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application. Because Lapidous does not disclose each and every element and limitation of the Applicants' claims, Lapidous does not anticipate Applicants' claims, and the rejections should be withdrawn.

Lapidous Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Lapidous disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Lapidous must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Lapidous places Applicants' claims in the possession of a person of ordinary skill in the art, Lapidous is legally insufficient to anticipate Applicants' claims under 35 USC 102(e).

Lapidous in fact does not place each and every element of claims 1, 3, 5-8, 9, and 14-16 in the possession of a person of skill in the art. Independent claim 1 of the present application claims:

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1. A computer program product embodied in a machine readable media and executable by a processor, said computer program product for use with a computer system having a display screen, a switch, and a pointing device for moving a cursor image on the display screen, said computer program product comprising program instructions for performing the steps of:

displaying an object on the display screen;

displaying a tooltip on the display screen in response to the positioning of the cursor image over the object,

continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.

Lapidous Does Not Place In Possession Of A Person Of Ordinary Skill In The Art Continuing To Display The Tooltip In Response To The Movement Of The Cursor From The Object To The Tooltip

The third element of claim 1 claims "continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip." Regarding the third element of claim 1, the Office Action at page 3 states that Lapidous at Figure 2, reference numeral 230, discloses:

continuing to display the tool tip in response to the movement of the cursor from the object to the tool tip (figure 2, cursor 230 is still placed over the tool tip).

That is, the Office Action takes the position that Lapidous at Figure 2, reference numeral 230, discloses the third element of claim 1 because the cursor 230 of Figure 2 in Lapidous is placed over the tool tip. Applicants respectfully note in response, however, that the cursor 230 of Figure 2 in Lapidous is placed over a floating control region 220 of Lapidous – not over a tool tip in Figure 2 of Lapidous. In fact, the element depicted in Figure 2 of Lapidous as tool tip is pop-up window 205 of Figure 2 in Lapidous. Lapidous at column 12, lines 7-17, describes pop-up window 205 of Figure 2 stating:

In the embodiment shown in FIG. 2, link 225 related to the supplemental content is rendered as an indicator that the main content can be replaced by clicking inside control region 220. In this way, the user is provided with a familiar metaphor of a tool tip, where pop-up window 205 starts

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behaving as a tool tip in relation to link 225 located inside the control region 220. That is, a control region surrounds a link while the associated content is displayed, and a cursor motion outside of the control region causes removal of the associated content.

That is, Lapidous at column 12, lines 7-17, describes pop-up window 205 of Figure 2 as a tool tip in relation to link 225 inside the control region 220. Because the cursor is not even close to the pop-up window 205 of Figure 2 in Lapidous, Lapidous's cursor 230 of Figure 2 cannot disclose continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application.

Even if the control region 220 were a tool tip, which it is not, Lapidous at Figure 2 does not disclose continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application because the control region 220 is not continuously displayed in response to the movement of the cursor from the object to the control region 220. The Office Action at page 2 asserts that the element of Figure 2 in Lapidous corresponding to the 'object' of claim 1 of the present application is the 'More information' region of Figure 2 in Lapidous stating:

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The control region 220 of Figure 2, however, is not displayed when the cursor 230 of Lapidous is over the 'More information' region of Figure 2 in Lapidous— rather, the floating control region 220 of Figure 2 in Lapidous is rendered beneath the cursor 230 of Figure 2 in Lapidous after the cursor 230 reaches the location of the cursor 230 depicted in Figure 2 of Lapidous. Lapidous at column 6, lines 23-36, states:

In this embodiment, once it is detected that the supplemental content is visible on the screen, the cursor motion is monitored for identifying a particular predefined event related to the cursor motion. This event may be a reduction in the cursor motion, an absence of the cursor motion for a predefined time interval, a particular movement of the cursor (e.g., a gesture to reproduce a circle), or any other similar event.

Once this event is identified, the cursor position at the time of this event is determined, and a floating control region is defined covering the cursor

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position. This control region is referred to as "floating" because its location on the screen is not fixed and depends on the cursor position at the time of the event.

That is, Lapidous at column 6, lines 23-36, states that the floating control region 220 is defined to cover the position of cursor 230 of Figure 2 in Lapidous. Once the cursor leaves the floating control region 220, the floating control region 220 of Figure 2 in Lapidous becomes invisible as described in Lapidous at column 6, lines 48-51, stating:

Once it is detected that the cursor is positioned outside of the control region, the supplemental content is removed from the screen. At this time, the control region also becomes invisible.

Because the floating control region 220 of Figure 2 in Lapidous is rendered at the location of the cursor 230 of Figure 2 in Lapidous and becomes invisible when the cursor 230 leaves the location depicted in Figure 2 of Lapidous, the control region 220 of Figure 2 in Lapidous is not continuously displayed in response to the movement of the cursor from the 'More information' region to the control region 220. Lapidous at Figure 2, therefore, does not place in possession of a person of ordinary skill in the art continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application. Because Lapidous does not place in possession of a person of ordinary skill in the art each and every element and limitation of the Applicants' claims, Lapidous does not anticipate Applicants' claims, and the rejections should be withdrawn.

Relations Among Claims

Independent claim 1 is patentable for the reasons discussed above. Independent claim 9 claims system aspects of the computer program product claimed in independent claim 1. Independent claim 9 therefore is patentable for the same reasons that independent claim 1 is patentable as described above. Dependent claims 3 and 5-8 depend from independent claim 1. Dependent claims 14-16 depend from independent claim 9. The dependent claims include each and every element and limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand. Claims 1, 3, 5-8, 9, and 14-16 are therefore patentable and should be

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allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1, 3, 5-8, 9, and 14-16.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C § 103(a) as unpatentable over Lapidous (U.S. Patent No. 6,874,126) in view of Official Notice of well known prior art ("Official Notice"). To establish a prima facie case of obviousness, the proposed combinations of the references must teach or suggest all of the claim limitations of claims 2, 4, and 10-13. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). For the reason discussed below, the Office Action does not teach or suggest all of the claim limitations of claims 2, 4, and 10-13. The Office Action, therefore, does not establish a prima facie case for obviousness, and the rejections should be withdrawn.

The Rejections Of Claims 2, 4, And 10-13 Rely On The Previous 35 U.S.C. § 102 Rejections

The Office Action does not teach or suggest all of the claim limitations of claims 2, 4, and 10-13 because the rejections of claims 2, 4, and 10-13 rely on the previous 35 U.S.C. § 102 rejections. The previous 35 U.S.C. § 102 rejections argue that Lapidous discloses each and every element and limitation of independent claims 1 and 9. As Applicants have demonstrated above, however, Lapidous does not disclose each and every element of independent claims 1 and 9. Claims 2 and 4 depend from independent claim 1. Claims 10-13 depend from independent claim 9. Each dependent claim includes all of the limitations of the claims from which they depend. Because the proposed combinations rely on the argument that Lapidous teaches each and every element of claims 1 and 9 and because Lapidous in fact does not teach or suggest each and every element of claims 1 and 9, the proposed combination cannot teach or suggest all the claim limitations of claims 2, 4, and 10-13. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

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The Combination Of Lapidous And Official Notice
Is Not Available To The Examiner

The Office Action does not teach or suggest all of the claim limitations of claims 2, 4, and 10-13 because the combination of Lapidous with Office Notice is not available to the Examiner. According to MPEP § 2144.03, the Examiner may make use of Official Notice of facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Official Notice, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated.

Regarding the rejection of claims 2 and 10, the Office Action states:

continuing to display the tool tip is in response to the movement of the cursor from the object to the overlapping portion of the too tip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tool tip was well known in the art.

That is, the Office Action makes a mere naked assertion that a fact is well known in the prior art with absolutely no objective evidence of record. As mentioned, Official Notice may not be substituted for facts which cannot be instantly and unquestionably demonstrated. In fact, Lapidous itself at column 2, lines 19-34, is evidence that the Office Notice taken in the Office Action cannot be instantly and unquestionably demonstrated stating:

It is known in the prior art to trigger automatic removal of the supplemental content by the cursor motion during the regular navigation process. For instance, supplemental content known as a tool tip appears when cursor stops over the link or an interface element. Internet browsers, such as the Internet Explorer.TM. (RTM), developed by the Microsoft Corporation, remove each displayed tool tip from the screen when the cursor moves into the area of the tool tip or exits a screen region associated with a related link or an interface element. Due in large part to this easy removal method, tool tips are widely used both for the links inside the hypertext documents and for the elements of the application user interfaces. However, usefulness of tool tips is limited by the difficulty of interaction with their content since the cursor motion to the tool tip automatically removes the tool tip from the screen.

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That is, Lapidous at column 2, lines 19-34, states that prior art teaches the removal a displayed tool tip from the screen when the cursor moves into the area of the tool tip or exits a screen region associated with a related link or an interface element. Lapidous, therefore, contradicts the statement of the Office Action that it is well known in the art to continue to display the tool tip is in response to the movement of the cursor from the object to the overlapping portion of the tool tip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tool tip. Because the Office Action contradicts Lapidous itself, the Official Notice taken in the Office Action cannot be capable of instant and unquestionable demonstration as well-known in the art, and the Office Action may not make use of Official Notice of facts outside the record. The Office Action, therefore, does not provide a combination of references that teaches or suggests all of the elements and limitations of claims 2 and 10. Because claims 4 and 11-13 depend from claims 2 and 10 respectively, the Office Action does not provide a combination of references that teaches or suggests all of the elements and limitations of claims 4 and 11-13. The Office Action, therefore, cannot establish a prima facie case of obviousness, the rejections of claims 2, 4, and 10-13 should be withdrawn, and the claims should be allowed.

CONCLUSION

Claims 1, 3, 5-8, 9, and 14-16 stand rejected under 35 U.S.C § 102(e) as being anticipated by Lapidous (U.S. Patent No. 6,874,126). For the reasons discussed above, Lapidous does not disclose each and every element of claims 1, 3, 5-8, 9, and 14-16 and Lapidous does not place one of skill in the art in possession of claim 1, 3, 5-8, 9, and 14-16. Lapidous therefore does not anticipate claims 1, 3, 5-8, 9, and 14-16 and the rejections should be withdrawn.

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C § 103(a) as unpatentable over Lapidous (U.S. Patent No. 6,874,126) in view of Official Notice of well known prior art ("Official Notice"). Because the proposed combinations rely on the argument that Lapidous teaches each and every element of claims 1 and 9 and because Lapidous in fact does not teach or suggest each and every element of claims 1 and 9, the proposed

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combination cannot teach or suggest all the claim limitations of claims 2, 4, and 10-13. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn. Claims 1-16 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-16.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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